

Applicants: Kohn et al.
Application No. : 09/350,423
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Docket No. P22,577-H USA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

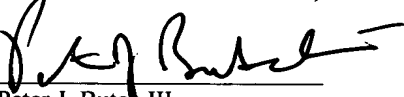
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| In re | Application of: | Kohn et al. | |
| | Application No.: | 09/350,423 | Art Unit 3743 |
| | Filed: | July 8, 1999 | Examiner N. Patel |

**ANIONIC BIODEGRADABLE POLYMERS DERIVED FROM THE AMINO
ACID L-TYROSINE**

(Attorney Docket No. P22,577-H USA)

Certificate of Mailing

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Peter J. Butcher III

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Reply to Requirement for Restriction Dated November 30, 2004

Sir:

In response to the Examiner's Action mailed November 30, 2004, applicants traverse hereby the Examiner's Requirement for Restriction set forth therein and request respectfully reconsideration and withdrawal of the Requirement.

The Examiner requires restriction between the following groups of claims:

Group I - The polymer compositions and methods for medical use of Claims 1-14, 21-23 and 27-38, classified in Class 424, Subclass 1.73; and

Group II - The medical devices for application of medicant of Claims 15 - 20 and 24 - 26, classified in Class 602, Sub-class 41.

The basis for the Examiner's Requirement for Restriction is that he considers the claim groups to be distinct because the medical device of Group II is capable of dispensing medicaments other than those claimed in Group I and the polymers claimed in Group I can be used for applications other than those recited in Group II.

It is submitted respectfully that the Examiner's Requirement is deficient on its face because 35 U.S.C. § 121 requires the involved inventions be not only distinct, but also independent. Clearly, the inventions defined in the claims of Groups I and II are not independent in that the Group I claims define a material that is used to prepare the articles and devices of the Group II claims.

Furthermore, contrary to the Examiner's classification, the polymers of Group I Claims 1-4, the methods of use of Group I Claims 27 – 32, and the synthesis methods of Group I Claims 33 – 38, as well as the devices of Group II Claims 15 – 17, do not necessarily function to apply a medicament. When the delivery of a medicament is recited, the same broad definition is employed in both claim groups. Therefore, the two claim groups are not distinct on the basis of the medicament applied.

The Examiner has recognized the claim groups do not define independent inventions because he has not characterized them as being independent. Moreover, the Examiner has not even attempted in his Action to explain why he considers the claims to be directed to independent inventions. Consequently, the Examiner has issued a requirement that is deficient on its face because he has not explained why the two claim groups are considered to define independent subject matter. Accordingly, the Requirement should be withdrawn.

It is submitted further that the Examiner's Requirement should be withdrawn because a proper search of the subject matter of the two claim Groups requires that a search be conducted for the subject matter of both groups of claims. This is because the subject matter of the claims is so interrelated. For example, the articles and devices of the Group II claims are prepared from the material of the Group I claims.

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As requested by the Examiner, applicants elect provisionally with traverse to prosecute polymer and medical use claims 1 – 14, 21 - 23 and 27 - 38 of Group I. Applicants request respectfully that, upon indication of allowable subject matter with regard to the elected claims, withdrawn Group II medical device claims 15- 20 and 24- 26, which include all the recitations of the polymer claims be rejoined for examination of patentability (M.P.E.P. Section 821.04).

It is believed that the claims in this application are in condition for allowance. A favorable action on the merits is respectfully requested. If there are any additional charges in connection with this response, the Examiner is authorized to charge Applicant's Deposit Account No. 19-5425 therefor.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter J. Butch III", with a long horizontal flourish extending to the right.

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